

REMARKS

I. Status of the Application

Claims 1-16 are all the claims pending in the Application. Claims 1-16 have been rejected.

The present amendment addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

II. Claim Rejections under 35 U.S.C. §103

The Examiner has rejected claims 1-2, 9 and 12-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,029,065 to Shah (hereinafter “Shah”), in view of U.S. Patent No. 5,745,852 to Khan *et al.* (hereinafter “Khan”). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

First, in Applicant’s previous Response under 37 C.F.R. §1.111 filed on December 22, 2005 (hereinafter “Applicant’s previous Response”), Applicant advanced arguments that the grounds of rejection failed to establish even a *prima facie* case of obviousness because they failed to provide a proper motivation to combine the teachings of Shah with those of Khan, in the specific manner proposed by the Examiner. Specifically, Applicant pointed out that the previous Office Action failed to provide any evidentiary support whatsoever for the alleged motivation to combine the cited references (i.e., that one would have been motivated to combine the teachings of Shah and Khan “for permitting the user to take advantage of the reduced call cost of the private base”).

However, the 03/09/06 Office Action fails to provide any response whatsoever to Applicant's arguments in this regard. To the contrary, the 03/09/06 Office Action completely ignores such arguments by stating that "in addition to the motivation already presented..." and then proceeding to cite an additional unsupported motivation to combine the reference teachings, without providing any evidence to support to originally cited motivation to combine. Indeed, the 03/09/06 Office Action again fails to cite any evidentiary support at all to support the bald assertion that one of ordinary skill in the art would have been motivated to combine Shah and Kahn "for permitting the user to take advantage of the reduced call cost of the private base," as alleged.

Therefore, since Applicant's previous arguments that the grounds of rejection have not established the requisite factual basis to support a legal conclusion of obviousness remain unrebutted by the 03/09/06 Office Action, claim 1 is patentable over the cited references for *at least* the reasons already of record. If the Examiner decides to persist in these grounds of rejection, Applicant's respectfully request that the Examiner provide the requisite factual basis to support these rejections by citing to specific portions of the cited references.

Second, in Applicant's previous Response, Applicant advanced arguments that the grounds of rejection fail to identify any specific teaching or suggestion regarding the desirability of combining Shah's means for facilitating a visiting mobile station's access to a visited network via a visited public base station, with the completely unrelated private base station taught in Khan, to arrive at the invention recited in claim 1. In particular, Applicant argued that Kahn specifically teaches away from the proposed combination since Khan teaches that the private

base stations taught therein operate at a greatly reduced power level than the public base stations of large cells, like those taught in Shah. (Col. 1, lines 22-23). As such, Applicant argued that Khan expressly teaches that the private base stations taught therein would not be suitable for providing access to a visiting mobile station, like that taught in Shah.

In response to Applicant's previous arguments in this regard, the 03/09/06 Office Action merely asserts that Kahn does not teach away from the proposed modification because Applicant's arguments "refer[ing] to the description of prior art without considering Kahn's improvements." More particularly, the 03/09/06 Office Action alleges that col. 1, lines 48-52 of Kahn teaches multiple mobile stations registering to use the private base station.

However, Applicant submits that even considering Kahn's purported improvement of "assignment of a local unique address for each one of the multiple mobile stations registering with the private base station," Kahn still expressly teaches away from combining Shah's means for facilitating a visiting mobile station's access to a visited network via a visited public base station, with the private base station taught in Khan. In addition to Khan's teaching (previously cited by Applicant) that conventional private base stations operate at a greatly reduced power level than the public base stations of large cells, like those taught in Shah,¹ Khan explicitly teaches that the private base station 20, disclosed therein, "is limited to a very low level of transmitted power for restricting its coverage range to a relatively small area." (Column 3, lines 46-48). Thus, Khan makes it clear that the private base stations therein are specifically tailored for private use within

¹ (Col. 1, lines 22-23).

a relatively small area, in stark contrast to the high-power public base stations, like those taught in Shah, which have a coverage range extending over an extremely large area.

At the very most, Khan teaches that multiple mobile stations may register to use the low-power private base station taught therein. But, no aspect of Kahn suggests the desirability of modifying the low-power prior art private base station so that it operates at a greatly increased power level like that of the public base stations of large cells taught in Shah. Therefore, even assuming *arguendo* that Kahn teaches that multiple mobile stations may register to use the private base station, as alleged in the grounds of rejection, Kahn nowhere provides any teaching or suggestion that it would be desirable to modify the private base station taught therein to operate at an increased power level suitable for public base stations, which would facilitate the access of Shah's visiting mobile stations (and, in fact, Khan teaches the complete opposite for the reasons already of record).

To be sure, Khan teaches away from such a proposed modification since Kahn's private base station is specifically tailored for short range private operation and is entirely unsuitable for facilitating public access to Shah's visiting mobile stations. Indeed, Shah teaches that each private station is connected to a user's private land-line subscriber telephone number, which teaches away from the notion of modifying such private bases to provide access to the public. (See col. 1, lines 23-25). Accordingly, Kahn clearly teaches away from the notion of combining Shah's means for facilitating a visiting mobile station's access to a visited network via a visited public base station, with the private base station taught in Khan.

Third, col. 1, line 65 – col. 2, line 1 of Kahn, does not stand for the proposition for which it is cited by the Examiner. The Examiner cites col. 1, line 65 – col. 2, line 1 of Kahn for the proposition that Khan “is directed to offering intelligent features to mobile station.” However, this portion of Kahn states only that “[t]his invention and its mode of operation will be more clearly understood from the following detailed description when read with the appended drawing in which: FIG. 1 shows a simplified block diagram of a cellular...” Moreover, contrary to the grounds of rejection, Khan is directed to a land-line supported private base station” and not to offering intelligent features to a mobile station, as alleged in the grounds of rejection (emphasis added). (Title). Thus, Applicant submits that the grounds of rejection are factually unsupported.

Fourth, Applicant submits that the Examiner has failed to provide the requisite evidentiary support for the newly alleged motivation to combine Shah and Kahn. The motivation for combining the teachings of Shah and Kahn cited by the 03/09/06 Office Action is “to extend the features coverage.” (03/09/06 Office Action, page 2). However, the Office Action does not point to any specific portion of the cited references to support such a motivation to combine the reference teachings. In fact, the Office Action does not provide any evidentiary support whatsoever for this alleged motivation.

Therefore, Applicant respectfully submits that independent claim 1 is patentable over Shah, Khan, and any combination thereof, for *at least* these independent reasons. Further, Applicant respectfully submits that the dependent claims 2, 9 and 12-14 are allowable, *at least* by virtue of their dependency on claim 1.

Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

B. Independent Claim 15

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited Shah and Khan references *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

C. Independent Claim 16

In view of the similarity between the recitations of claim 16 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited Shah reference *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

III. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Khan and further in view of Sipilä

The Examiner has rejected claim 3 as being unpatentable over Shah, in view of Khan, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

Claim 3 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the

teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Sipilä also fails to remedy these deficiencies. Therefore, Applicant respectfully submits that claim 3 is patentable over Shah, Kahn, Sipilä, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

IV. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, and further in view of Kasmperschroer

The Examiner has rejected claims 4 and 6-7 as being unpatentable over Shah, in view of Khan, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 4 and 6-7 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. In addition, both Sipilä and Kasmperschroer also fail to remedy these deficiencies. Hence, Applicant respectfully submits that claims 4 and 6-7 are patentable over Shah, Kahn, Sipilä, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

V. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, further in view of Kasmperschroer, and further in view of Heuvel

The Examiner has rejected claim 5 as being unpatentable over Shah, in view of Khan, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter “Heuvel”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

Claim 5 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Sipilä, Kasmperschroer, and Heuvel all fail to remedy these deficiencies. Therefore, Applicant respectfully submits that claim 5 is patentable over Shah, Kahn, Sipilä, Kasmperschroer, Heuvel and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

VI. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Kasmperschroer

The Examiner has rejected claims 8-11 as being unpatentable over Shah, in view of Khan, and further in view of Kasmperschroer. Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 8-11 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the

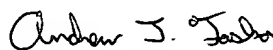
teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Kasmperschroer also fails to remedy these deficiencies. Therefore, Applicant respectfully submits that claims 8-11 are patentable over Shah, Kahn, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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